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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Clark et al Group Art Unit: 3627
Serial No.: 09/560,785 Examiner: Andrew J. Fischer
Filed: April 28, 2000
For: Method For Designing And Purchasing A Product
Attorney Docket No.: 67600-037 (200-0505)

CERTIFICATE OF MAILING OR FACSIMILE TRANSMISSION

I hereby certified that this correspondence is (1) ☐ being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450 on August ____, 2007; or (2) ☒ being facsimile transmitted to the United States Patent and Trademark Office at facsimile number (571)-273-8300 on August 9, 2007.

Randy W. Tung
Printed Name


Signature

8/9/07
Date

Please forward all correspondence to
TUNG & ASSOCIATES
838 W. Long Lake Road, Suite 120
Bloomfield Hills, MI 48302

Response to Non-Compliance

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

In response to an Office Action mailed 07/09/2007, the Applicants respectfully submit the attached revised appeal brief.

The Applicants respectfully submit that the revisions that have been required by the Examiner to the present Appeal Brief are improper under MPEP § 41.37, which delineates the requirements for an Appeal Brief. MPEP § 41.37 concludes with the following: "Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004" The Applicants' initial Appeal Brief was filed on or about December 15, 2003. Therefore, the Applicants respectfully submit that the present Appeal Brief must properly conform to the format required of an Appeal Brief before the changes effective September 13, 2004.

In order to expedite the process of examination, the Applicants have amended the Appeal Brief in accordance with the requirements of the Examiner.

In the Notification of Non-Compliant Appeal Brief mailed on July 9, 2007, check box number 3 is checked, indicating that, "At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37 (c) (1) (iv))."

It is unclear as to what the Examiner intended, as the Appeal Brief clearly states that, "A Request for Reconsideration amending Appellant's application under 37 CFR \$1.116 was filed on or about July 22, 2003 and was not entered." Thus, the Appeal Brief states that the amendment made subsequent to final rejection was not entered.

In item 2 on the continuation sheet of the Notification of Non-Compliant Appeal Brief mailed on July 9, 2007, the Examiner stated, "The copy of claims should not include any markings, such as brackets or underlines. Only one copy of the claims appendix should be submitted." It is unclear as to what the Examiner intended, as the Claims Appendix does not contain any markings, brackets, or underlines.

In item 5 on the continuation sheet of the Notification of Non-Compliant Appeal Brief mailed on July 9, 2007, the Examiner stated, "In the status of amendments section states an amendment AF was filed on 07/22/03, however after reviewing the application the amendments filed after the final rejection were dated 08/18/03 and 09/16/03." It is unclear what the Examiner intended, as the records on file with the Applicants' attorney indicate that the filing of the above amendments occurred on the dates indicated in the appeal brief as filed.

Respectfully submitted,



Randy W. Tung,
Registration No. 31311

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Clark et al Group Art Unit: 3627
Serial No.: 09/560,785 Examiner: Andrew J. Fischer
Filed: April 28, 2000
For: Method For Designing And Purchasing A Product
Attorney Docket No.: 67,600-037 (200-0505)

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Randy W. Tung
Printed Name


Signature

8/9/07
Date

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Bloomfield Hills, MI 48302

FOURTH REVISED APPEAL BRIEF

Assistant Commissioner
for Patents
P.O. Box 1450
Alexandria, Va 22313-1450

Sir:

Appellant appeals in the captioned application from the Examiner's Final Office Action mailed May 13, 2003, (hereinafter "Final Office Action") rejecting claims 1-7, and 13-16 under 35 USC § 112, first and second paragraphs, rejecting claims 1-5, and 13-16 under 35 USC §103(a) as being obvious over Johnson U.S. Patent NO. 6,023,683 (hereinafter "JOHNSON") in view of Jolliffe et. al. U.S. Patent NO. 5,646,862 (hereinafter "JOLLIFFE"), and rejecting claims 6-7 as being obvious over JOHNSON/JOLLIFE

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combination in further view of Danneels et. al. U.S. Patent NO.
6,272,472 B1 (hereinafter "DANNEELS").

It is urged that the rejections be reversed and that all the
rejected claims be allowed.

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(1) REAL PARTY IN INTEREST

The real party in interest in the present appeal is the recorded Assignee, Ford Global Technologies, LLC.

(2) RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that are known to the Appellant, the Appellant's legal representative, or the assignee.

(3) STATUS OF THE CLAIMS

Claims 1-7, and 13-16 are pending in the application.

Claims 8-12 were cancelled.

Claims 1-7, and 13-16 stand rejected. No claims are allowed.

Claims 1-7, and 13-16 are being appealed.

(4) STATUS OF AMENDMENTS

A First Office Action rejecting all claims was mailed November 18, 2002.

A Response to the November 18, 2002 Office Action was filed on or about February 18, 2003 and was entered.

A Final Office Action rejecting all claims was mailed on May 13, 2003.

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A Request for Reconsideration amending Appellant's application under 37 CFR §1.116 was filed on or about July 22, 2003 and was not entered.

An Advisory Action rejecting claims 1-7 and 13-16 was mailed on or about September 25, 2003.

A Notice of Appeal was filed on or about October 14, 2003.

An Appeal Brief was filed on or about December 15, 2003.

A Notice of Defective Appeal Brief was mailed on March 12, 2004.

A First Revised Appeal Brief was filed on or about April 12, 2004.

A Notice of Non-Compliant Appeal Brief was mailed on June 1, 2006.

A Response to Notification of Non-Compliant Appeal Brief was filed on or about June 30, 2006.

A Notification of Non-Compliant Appeal Brief was mailed on November 15, 2006.

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(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

"This invention relates to a method for designing and purchasing a product and more particularly, to a method for dynamically identifying and evaluating various products and for dynamically identifying and evaluating various components and suppliers which may be used to produce a product which meets a certain previously identified need."

(Specification, page 1, lines 7-13)

"In order to allow the data or information to be efficiently categorized and acquired, each supplier 36,38 is required to have a template such as template 50 in Figure 2."

(Specification, page 9, lines 4-7)

"As used within this description, the term "product" means any tangible item which must be created or obtained and which meets certain needs or requirements of a business organization and/or certain customers of such a business organization."

(Specification, page 1, lines 23-27)

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"[A] method for designing and purchasing a product which . . . which dynamically identifies sources of the product and sources of components which may be cooperatively assembled to produce the product."

(Specification, page 3, lines 8-13)

"[A] method for designing and purchasing a product which dynamically queries potential suppliers of such products for information effective to allow the potentially sourced products to be evaluated according to a dynamically configurable criteria."

(Specification, page 3, lines 23-26
through pg. 4, lines 1-4)

"[T]he basic tangible elements which cooperatively form the product are identified".

(Specification, page 6, lines 22-23)

"[A]ny interrelationship attributes (i.e., attributes related to the interrelationship of the product to other products or components) are identified."

(Specification, page 7, lines 10-14 (emphasis added))

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"For instance, the needed gear assembly may require a pair of dissimilar gears which are coupled in a certain manner in order to provide the desired coupling function."

(Specification page 6, lines 18-21)

"The last step of process 10 requires that a recommendation be issued or generated which specifies the identity of the desired final assembly provided or combination of component providers."

(Specification page 8, lines 10-13)

"The recommendations may be used to purchase and/or otherwise acquire a product."

(Specification page 8, lines 16-17)

"[T]emplate 50 includes a first dynamically configurable and searchable field 52 which identifies an item (i.e. a final assembly or component). Template 50 further includes a dynamically configurable and searchable field 54 which specifies the physical attributes of the item and **a dynamically configurable and searchable field 56 which specifies the attributes related to the interrelationship of this item to other items or components.**"

(Specification, page 9, lines 7-15 (emphasis added))

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"These templates 50 are created for each component, product or final assembly which is produced by each respective supplier 36, 28 and are dynamically updated to allow modifications and changes to be made to the products and to reflect the creation of new products and components."

(Specification, page 9, lines 17-22)

"[C]omputerized design files may be transmitted by the potential supplier 36, 38 to the purchaser 32, effective to allow the purchaser 32 to determine whether the sourced components and/or product meets the technical need of the organization. These files may also selectively be used to construct a three dimensional prototype as described within the text entitled Direct Engineering-Toward Intelligent Manufacturing edited by Ali K. Kamrani and Peter R. Sferro (Kluwer Academic Publishers), ISBN 0-7923-8338-9, which is fully and completely incorporated herein by reference."

(Specification, pg. 10, lines 1-11)

"Step 14 follows step 12, and in this step, a product (i.e., a tangible item) is identified to meet this perceived need. For example, a gearing assembly may be needed to allow these two portions or elements to be coupled in the desired manner. Step

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16 follows step 14, and in this step, the individual components of the needed assembly are identified or 'decomposed'."

(Specification, pg. 6, lines 12-18)

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground I

Is the Final Office Action rejection of claims 1-7 under 35 USC § 112, first paragraph, as failing to clearly define subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention proper when independent claim 1, from which claims 1-7 depend was amended to clearly define the subject matter of the claimed invention?

Ground II

Is the Final Office Action rejection of claims 13-16 under 35 USC § 112, first paragraph, as failing to clearly define subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention proper when independent claim

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13, from which claims 14-16 depend, was amended to clearly define the subject matter of the claimed invention?

Ground III

Is the Final Office Action rejection of claim 1 under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention proper when independent claim 1, from which claims 2-7 depend, was amended in Appellant's Request for Reconsideration filed on or about July 22, 2003 to define the Appellant's invention by particularly pointing out and distinctly claiming the subject matter which appellant regards as the invention?

Ground IV

Is the Final Office Action rejection of claims 13-16 under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention proper when claim 13, from which claims 14-16 depend, was amended in Appellant's Request for Reconsideration filed on or about July 22, 2003 to define the Appellant's invention by particularly pointing out and

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distinctly claiming the subject matter which appellant regards as the invention?

Ground V

Is the Final Office Action rejection of claims 1-5 under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE and the rejection of claims 6-7 under 35 USC §103(a) as being obvious over JOHNSON/JOLLIFFE combination in view of DANNEELS proper when such references do not disclose, teach, or suggest the specifically claimed limitations of claims of 1-7?

Ground VI

Is the rejection of claims 13-16 under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE proper when such references do not disclose, teach, or suggest the specifically claimed limitations of claims of 13-16?

(7) ARGUMENT

Issue I

The rejection of claims 1-7 under 35 USC § 112, first paragraph is improper and must be reversed.

Claim 1-7 were rejected in the Final Office Action under 35 USC § 112, first Paragraph, as failing to clearly define subject

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matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

More particularly, the Final Office Action, pg. 3, clause 5, stated the rejection under 35 UCS 112 first paragraph was based on the uncertainty of "how "purchasing said product from said at least one identified supplier" occurs since this would make irrelevant the earlier claimed distinction of searching for components from particular suppliers."

Independent Claim 1, as amended, clearly defines the step of "creating an information template for each of the plurality of suppliers" and to clearly define the step of "searching each of the information templates for the specified components disposed within each product".

As appellant is entitled to be "his or her own lexicographer", see Multifarm Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998), the term "product" as used within appellant's originally submitted application "means any tangible item which must be created or

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obtained and which meets certain needs or requirements of a business organization and/or certain customers of such a business organization." Appellant's Specification, page 1, lines 23-27.

Thus, the present invention provides "a method for designing and purchasing a product ... which identifies potential sources of the product and/or of components which may be assembled to produce such a product while technically and economically evaluating each of the potentially sourced products and component combinations." See also, Appellant's Specification, page 3, lines 15-22.

Thus, a product having only one component allows a single component to be a product. Additionally, if each product has at least one component, then a search of each of the information templates for each supplier would necessarily search the product and the at least one component disposed within the product. Likewise, a search of each of the information templates would necessarily search a product and each component within a product if the product had more than one component.

Additionally, "the basic tangible elements [i.e. components] which cooperatively form the product are identified".

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Appellant's Specification, page 6, lines 21-26. Therefore, in light of independent claim 1 as amended, the rejection of claim 1 and claims 2-7, which depend from claim 1, under 35 USC §112, first paragraph must be reversed.

Issue II

The rejection of claims 13-16 under 35 USC § 112, first paragraph is improper and must be reversed.

Claims 13-16 were rejected in the Final Office Action under 35 USC § 112, first Paragraph, as failing to clearly define subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

More particularly, the Final Office Action, 7, clause 6a, stated claim 13 was rejected based on the consideration that the phrase "creating an information template having a dynamically configurable and searchable field ..." contains new matter.

The appellant respectfully disagrees. Claim 13 as amended to clearly defines the step of "creating an information template having a dynamically configurable and searchable field which

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specifies a plurality of attributes related to an interrelationship of the several interconnected components for each of said plurality of suppliers, each of said information templates further containing information identifying the respective products and components provided by the supplier, a cost of producing each of said respectively provided products and components, and the time required to provide each of said respective products and components"

Appellant's Specification clearly supports and provides antecedent basis for "an information template having a dynamically configurable and searchable field" recited in amended claim 13 as disclosed in the originally submitted specification, page 9, lines 7-15 as follows:

"[T]emplate 50 includes a first **dynamically configurable and searchable field 52** which identifies an item (i.e. a final assembly or component). Template 50 further includes a **dynamically configurable and searchable field 56** which specifies the attributes related to the interrelationship of this item to other items or components."

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Therefore, claim 13 does not introduce new matter because antecedent basis is provided in the originally submitted specification for an information template having a dynamically configurable and searchable field. In light of claim 13 as amended, the rejection of claim 13, and claims 14-16, which depend from independent claim 13 must be reversed.

Issue III

The rejection of claim 1 under 35 USC § 112, second paragraph is improper and must be reversed.

Claim 1 under 35 USC § 112, second paragraph, was rejected in the Final Office Action as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. More particularly, the Final Office Action, pg. 4, clause 8a, rejected claim 1 based on the uncertainty of whether "the computerized design file" recited therein is associated with the product or is associated with a component.

Claim 1 clearly defines the computerized design file. Claim 1 recites the steps of:

"searching each of the information templates for the specified components disposed within each product;

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identifying at least one supplier from the plurality of suppliers by use of said search;

causing a design file of said product to be created by performing the steps of

transmitting at least one computerized design file associated with each component disposed within said product created from each of said identified suppliers from the plurality of suppliers to a purchaser, and

selectively using said at least one transmitted computerized design file to create a three dimensional prototype of said product; and

purchasing said product from said at least one identified supplier from the plurality of suppliers."

As defined in claim 1, the product has at least one component disposed within the product, and therefore, the computerized design file is associated with the component. Thus, the at least one component design file is used to create the 3-D prototype. See Appellant's Specification, page 3, lines 23-26 through page 4, lines 1-4; page 9, lines 17-22;, and page 10, lines 1-11.

Additionally, the Final Office Action, page 4, clause 8b, rejected claim 1 based on the uncertainty of whether the step of "purchasing said product from said at least one identified

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supplier" provides for each supplier to only supply a component. As discussed supra, regarding claim 1, if a product has one component, then only one product would be purchased by the supplier, but if the product comprises multiple components, then multiple "products" or components may be purchased from the supplier. See Appellant's Specification, page 3, lines 15-22, and page 6, lines 21-26.

Additionally, the Final Office Action, page 5, clause 8c, rejected claim 1 based on the uncertainty of whether the "searching" and "transmitting" step was performed for just a single component or for all components. Claim 1, as amended, associates the searching and transmitting step with each component disposed within said product. As mentioned supra, the at least one component is disposed within the product and when the product has only one component, the product is the component. If the product has a plurality of components, then each of the component design files are searched and transmitted. See Appellant's Specification, page 3, lines 15-22, and page 6, lines 21-26.

Additionally, the Final Office Action, page 5, clause 8d, rejected claim 1 based on the uncertainty of whether the step of

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"causing a design filed of said product to be created . . ." includes all three sub-steps of "transmitting," "using," and "purchasing".

Additionally, claim 1 as amended clearly defines the step of "causing a design filed of said product to be created".

The step of "causing a design filed of said product to be created" has the two sub-steps of "transmitting and selectively using". The step of "causing a design filed of said product to be created" is identified as an ordinary step apart from the ordinary step of "purchasing said product . . ." Both of these ordinary steps are defined in separate parts of the specification. See Appellant's Specification, pg. 10, lines 1-11 (defining the sub-steps of transmitting and selectively using); see also Appellant's Specification page 8, lines 10-13, and 16-17 (defining the step of purchasing a product based on predefined recommendations, i.e. after a design file has been created).

Further evidence as to the step of "purchasing said product . . ." being an ordinary step apart from and not a sub-step of the step of "causing a design filed of said product to be created" is shown in the actual grammatical structure of claim 1. As recited

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in claim 1, the two sub-steps of transmitting and selectively using are separated by a comma, whereas the ordinary step of "purchasing said product ..." is separated by a semicolon from the step of "causing a design filed of said product to be created" having the two sub-steps. Thus, as indicated by the structure of claim 1, the step of "purchasing said product ..." is an ordinary step, and is not a substep. In light of the arguments outlined supra and the structure of independent claim 1, the rejection of claim 1 and claims 2-7, which depend from claim 1, the rejection under 35 USC §112, second paragraph must be reversed.

Issue IV

The rejection of claims 13-16 under 35 USC § 112, second paragraph is improper and must be reversed.

Claims 13-16 under 35 USC § 112, second paragraph, were rejected in the Final Office Action as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

More particularly, the Final Office Action, pg. 6, clause 8e stated that claim 13 was rejected based on the uncertainty of how

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the information template which corresponds to the particular suppliers is dynamically configurable. Claim 13 clearly defines the information template to have "a dynamically configurable and searchable field **which specifies a plurality of attributes related to an interrelationship of the several interconnected components for each of said plurality of suppliers**". Thus, claim 13 explains how the information template which corresponds to the particular suppliers is dynamically configurable by specifying a plurality of interrelationship attributes. See Appellant's Specification, page 6, lines 18-23 and page 7, lines 10-14. Therefore, in light of independent claim 13, the rejection of claim 13 and claims 14-16, which depend from claim 13, the rejection under 35 USC §112, second paragraph must be reversed.

Issue V

The rejection of claims 1-5 under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE and the rejection of claims 6-7 under 35 USC §103(a) as being obvious over JOHNSON/JOLLIFFE combination in view of DANNEELS is improper when such references do not disclose, teach, or suggest the specifically claimed limitations of claims of 1-7.

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The rejection of claims 1-5 under 35 USC § 103(a) based on JOHNSON in view of JOLLIFFE is improper and must be reversed.

Claims 1-5 are rejected under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE. It is contended in the Final Office Action, pg. 7, clause 10, that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson '683 as taught by Jolliffe to include creating a three dimensional prototype of the component or product." The Appellant respectfully disagrees. The JOHNSON reference is directed to a method of purchasing products from a supplier catalog, creating a catalog database of products listed within a plurality of supplier catalogs, wherein each product is displayed within an associated supplier catalog, and requisitioning an available product **based on a best price** from a selected supplier catalog. See Johnson col. 4, lines 35-41. Johnson teaches "a catalog database 36 comprised preferably of at least two vendor product catalogs. The catalogs, and hence catalog database 36, preferably include such information as part number, price, catalog number, vendor name or I.D., and vendor catalog number, **as well as textual information and images** of or relating to the catalog products." Johnson col. 4, lines 35-41.

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"The data passed by interface 60 preferably comprise all or a subset of the following twelve fields: vendor name, vendor number, vendor part (catalog) number, product description, bid price, list price, keyword, page number, quantity, unit, catalog text, and catalog images." JOHNSON col. 5, lines 66-67 through col. 6, lines 1-3.

JOHNSON uses an interface to pass 12 fields from a supplier to the catalog database and then searches the 12 fields for products that match pre-defined catalog search criteria to form a purchase requisition. See JOHNSON col. 6, lines 5-22. The 12 fields comprise: "vendor name, vendor number, vendor part (catalog) number, product description, bid price, list price, keyword, page number, quantity, unit, catalog text, and catalog images." JOHNSON col. 5, lines 65-67 through col. 6 lines 1-3.

The JOLLIFFE reference generally teaches the concept of designing vendor-neutral engineering systems, particularly involving electrical engineering systems that are part of an automobile. The JOLLIFFE reference further teaches a generic translation software that operates between two different Computer Aided Engineering (CAE) tools. See JOLLIFFE, col. 5, lines 27-31 ("In its simplest form, the system disclosed is thus a method for data exchange and communication between vendor independent tools

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and tools that do not necessarily speak the same language or have the same concepts.")

Additionally, JOLLIFFE uses a 2-dimensional CAD file for use in designing an optimal electrical system. See generally JOLLIFFE and FIGS. 1-14. JOLLIFFE also teaches a limited use of a CAE tool that is used to design a 3-D harness: "There might also be additional tools (not shown) which perform full 3-D harness design." JOLLIFFE, col. 5, lines 5-7.

To the contrary, independent claim 1 of Appellant's Application clearly recites a method for purchasing a product having the steps of:

"identifying a plurality of suppliers;

creating an information template for each of the plurality of suppliers;

specifying a product and each component within the product;

searching each of the information templates for the specified components disposed within each product;

identifying at least one supplier from the plurality of suppliers by use of said search;

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causing a design file of said product to be created by performing the steps of

transmitting at least one computerized design file associated with each component disposed within said product created from each of said identified suppliers from the plurality of suppliers to a purchaser, and

selectively using said at least one transmitted computerized design file to create a three dimensional prototype of said product; and

purchasing said product from said at least one identified supplier from the plurality of suppliers."

The Appellant respectfully submits that such is not taught or disclosed by JOHNSON in combination with JOLLIFFE. The United States Court of Appeals for the Federal Circuit (CAFC) has stated in determining the propriety of a rejection under 35 U.S.C. § 103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q2d 1596 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir.

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1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). The law followed by our court of review and the Board of Patent Appeals and Interferences is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976). See also In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.") The determination under § 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. Kahn v. General Motors Corp., 135 F.2d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998). See In re O'Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) ("Obviousness may not be established using hindsight."); see W.L. Gore & Assocs., Inc. v. Garlock, Inc. 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983) ("In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety.").

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With respect to the rejection of independent claim 1 none of the references cited, either alone or in combination with each other, teach or suggest the claimed invention. The proposed combination fails to yield Appellants' invention in as much as claim 1 requires a step of **"selectively using said at least one transmitted computerized design file to create a three dimensional prototype of said product."** "Product" as used within Appellant's Specification "means any tangible item which must be created or obtained and which meets certain needs or requirements of a business organization and/or certain customers of such a business organization." Appellant's Specification, page 1, lines 23-27. See also, Appellant's Specification, page 3, lines 15-22 disclosing "a method for designing and purchasing a product . . . which identifies potential sources of the product and/or of components which may be assembled to produce such a product while technically and economically evaluating each of the potentially sourced products and component combinations."

As mentioned in the Final Office Action, pg. 7, and in Appellant's April 22, 2003 Reply (Paper No. 6), the JOHNSON reference fails to disclose use of a three dimensional image to produce a prototype of the product as defined in claim 1. It is

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well known in the automotive electrical arts that a 3-D harness design may be used to determine the relative loads, transients, and distances of the wires disposed within a wiring harness. Such a 3-D harness design as described in JOLLIFFE may be created using the method of the present invention. However, the same 3-D harness design tool could not create a three dimensional prototype of **any product** as defined in the present invention using the JOLLIFFE method.

Additionally, the JOLLIFFE reference teaches away from using a general design method for designing an non-electrically related product as disclosed in the present invention. See JOLLIFFE, col. 10, lines 21-26.

"In keeping with the present invention, there is further provided a method for accommodating data interchange between multiple vendor-independent Computer Aided Engineering (CAE) tools. **The method is specifically directed for use in an integrated vehicle electrical design and analysis system.**" JOLLIFFE, col. 10, lines 21-26.

Thus, the 3-D wiring harness of JOLLIFFE alone or in combination with other wiring harnesses cannot create a 3-dimensional prototype of a fully surfaced and textured automotive

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component or product. Therefore, a 3-D CAD file of a wiring harness cannot be combined with the template of the JOHNSON reference to render a 3-D "product" prototype as is disclosed in the present invention. Therefore, there is no motivation to combine the JOHNSON reference with the JOLLIFFE reference to render appellant's invention.

Additionally, even if a motivation to combine the JOHNSON reference with the JOLLIFFE reference exists, the results of the combination of the two references of record would still not render the 3-dimensional product prototype design produced using the present invention. For example, if the pre-defined fields of the catalog template taught in the JOHNSON reference, particularly the textual information and 2-dimensional catalog images, were able to be translated into a vendor-neutral language using the method of the JOLLIFFE reference, only 2-dimensional images or data relating to electrical systems could be used in accordance with the JOLLIFFE method and furthermore, the images could not be converted into a 3-D product prototype using the JOLLIFFE method. Conversely, using the method of the JOHNSON reference, data relating to a 3-D wiring harness of the JOLLIFFE invention would still be transmitted as 2-dimensional image using the catalog image template field of the JOHNSON invention. Therefore, it would not be obvious to combine the teachings of

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the JOHNSON reference with the teachings of the JOLLIFFE reference to render the 3-D prototype design of a product of the present invention.

The Appellant therefore respectfully submits that Appellant's claims are not rendered obvious under JOHNSON in view of JOLLIFFE because the JOHNSON and JOLLIFFE reference alone or in combination do not teach, disclose or suggest a 3-D prototype design of a product of the present invention. The rejection of claims 1-5 under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE is improper when such reference does not disclose, teach, or suggest the specifically claimed limitations of claims of 1-5. The rejection of claims 1-5 under 35 USC § 103(a) based on JOHNSON in view of JOLLIFFE is improper and must be reversed.

The rejection of claims 6-7 under 35 USC §103(a) as being obvious over JOHNSON/JOLLIFFE in further view of DANNEEL is improper and must be reversed.

The Daniels reference teaches a dynamic linking system that facilitates communications between three system components: a supplier server, a reseller server, and a purchaser client web

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browser. See DANNEELS col. 4, lines 22-23. DANNEELS enables a purchaser to select a reseller from a list of resellers supplied by the supplier server to purchase a desired item from a reseller that sells the associated desired item.

The Appellant's have clearly shown that the basic steps of "selectively using said at least one transmitted computerized design file to create a three dimensional prototype of said product" as recited in independent claim 1, of Appellant's Application is not taught or disclosed by JOHNSON or JOLLIFFE. The additional reference of DANNEELS therefore does not lend any additional weight in a 35 USC §103(a) rejection of claims 6-7.

Additionally, as discussed supra, there is no motivation to combine, nor would it have been obvious to combine the JOHNSON reference with the JOLLIFFE reference to render the present invention. Thus, there also exists no motivation to combine the JOHNSON reference and the JOLLIFFE reference with the DANNEELS reference to render further combining the present invention. The rejection of claims 6-7 under 35 USC § 103(a) based on JOHNSON/JOLLIFFE in further view of DANNEELS is improper and must be reversed.

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Issue VI

Claims 13-16 are rejected under 35 USC §103(a) as being obvious over JOHNSON in view of JOLLIFFE.

It is contended in the Final Office Action that the JOHNSON reference inherently discloses searching with templates by both product and component such as in auto parts. Additionally, the Final Office Action contends that decomposing said product into several interconnected components is inherent since the part number would already reflect this decomposition.

The Appellant respectfully disagrees. With respect to the rejection of independent claim 13 none of the references cited, either alone or in combination with each other, teach or suggest the claimed invention. The proposed combination fails to yield Appellants' invention in as much as claim 13 requires a step of clearly defining the information template associated with each supplier and with each product. Appellant, being his own lexicographer, see MPEP 2111.01, hereby defines "interrelationship" to mean how each of the products or components disposed within the products spatially relate to one another, or similarly, how the item [i.e. product or component]

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relates to other items [i.e. products components]. See Appellant's Specification, page 7, lines 10-14:

"Step 18 follows step 16, and in this step, . . . any **interrelationship attributes (i.e., attributes related to the interrelationship of the product to other products or components)** are identified." See Appellant's Specification, page 7, lines 10-14.

See also, Appellant's Specification, page 6, lines 18-23 describing the interrelationship of two components used to form a product: "For instance, the needed gear assembly may require a pair of dissimilar gears which are coupled in a certain manner [i.e. "interrelationship between the pair of dissimilar gears"] in order to provide the desired coupling function. Therefore, in this step 16, **the basic tangible elements [i.e. "components"] which cooperatively form the product are identified.**"

Patents are written by and for skilled artisans, see Vivid Technologies v. American Signs, 200 F.3d 795, 804, 53 USPQ2nd 1295, see also S3 v. Nvidia, 259 F.3d 1354, 1371, 59 USPQ 2nd 1795, 1749-50. Thus, the definition and use of "interrelationship" with regard to automotive products or components is well known in the art. Use of the term

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"interrelationship" can be found in PRYOR, U.S. Patent No. 5, 380,978 entitled "Method and apparatus for assembly of car bodies and other 3-dimensional objects", issued on Jan. 10, 1995 discussing the "interrelationship" of components being assembled in an automotive manufacturing environment. "This is quite different than today's practice, where sub-assemblies are built up, even in other factories, hundreds of miles away, and one really has no knowledge of the **interrelationship** of the dimensions of the various pieces. One only "hopes" that it goes together." PRYOR, col. 13, lines 33-37.

Thus, "interrelationship" can be interpreted as the physical location of a structural relationship of one component or product to another. Therefore, claims 13-16 must be examined in light of the definitions provided by the appellant lexicographer in the specification as discussed supra.

Using appellant's definition of the term interrelationship", no such template having a dynamically searchable field for defining **interrelationship attributes** is provided in either the JOHNSON or the JOLLIFFE reference.

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Both the JOHNSON and the JOLLIFFE reference fail to disclose "an information template having a dynamically configurable and searchable field which specifies a plurality of attributes related to an interrelationship of the several interconnected components for each of said plurality of suppliers" as recited in claim 13. While the fields of the template taught in JOHNSON may have pre-defined but searchable fields, none of the pre-defined values within the fields define an interrelationship of the several interconnected components of the product identified.

With regard to the JOHNSON reference, the hit list consists of a list of product part descriptions and numbers and the textual information field as taught in the JOHNSON reference lists factual information and some physical specifications of the product or component as a whole, but fails to describe the interrelationship of the product with regard to another product, or of a component with regard to another component. See JOHNSON appendices. Additionally, no such template or fields are taught in the JOLLIFFE reference. Thus, there is no motivation to combine the JOHNSON reference with the JOLLIFFE reference to render appellant's invention.

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Thus, the rejection of claims 13-16 under 35 USC § 103(a) based on JOHNSON in view of is improper and must be reversed.

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CLOSING

In summary, Appellant has shown that Appellant's claimed invention is fully supported by a body of evidence of definiteness, and non-obviousness. It is respectfully submitted that such evidence of definiteness and non-obviousness overcomes any showing of indefiniteness and obviousness presented by the Examiner. The Appellant therefore submits that the following final rejections are improper:

- 1) Appellant's claims 1-7, and 13-16 under 35 USC § 112, first paragraph;
- 2) Appellant's claims 1-7, and 13-16 under 35 USC § 112, second paragraph; and
- 3) Claims 1-7, and 13-16 under 35 USC § 103(a).

The reversal of the final rejection is respectfully solicited from the Board.

Respectfully submitted,

Randy W. Tung,
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CLAIM APPENDIX

1. A method for purchasing a product comprising the steps of:
 - identifying a plurality of suppliers;
 - creating an information template for each of the plurality of suppliers;
 - specifying the product and each component within the product;
 - searching each of the information templates for the specified components disposed within each product;
 - identifying at least one supplier from the plurality of suppliers by use of said search;
 - causing a design file of said product to be created by performing the steps of
 - transmitting at least one computerized design file associated with each component disposed within said product created from each of said identified suppliers from the plurality of suppliers to a purchaser, and
 - selectively using said at least one transmitted computerized design file to create a three dimensional prototype of said product; and
 - purchasing said product from said at least one identified supplier from the plurality of suppliers.

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2. The method of claim 1 further comprising the steps of:

placing certain information on said information template of said identified supplier related to the cost of producing said product; and

reporting said certain information.

3. The method of Claim 2 further comprising the steps of:

storing said three dimensional prototype of said product within an associated information template database; and

evaluating said design file before purchasing said product.

4. The method of claim 1 further comprising the step of:

creating information relating to the operation of said product; and

placing said information upon said template of said identified supplier.

5. The method of Claim 1 wherein said product is selectively assembled within a vehicle.

6. The method of Claim 1 wherein said templates are searched over a global computer network.

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7. The method of Claim 6 wherein said global computer network comprises the internet.

8. (cancelled)

9. (cancelled)

10. (cancelled)

11. (cancelled)

12. (cancelled)

13. A method for purchasing a product comprising the steps of:
fixing attributes of said product;
decomposing said product into several interconnected components;
identifying a plurality of suppliers;
creating an information template having a dynamically configurable and searchable field which specifies a plurality of attributes related to an interrelationship of the several interconnected components for each of said plurality of suppliers, each of said information templates further containing

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information identifying the respective products and components provided by the supplier, a cost of producing each of said respectively provided products and components, and the time required to provide each of said respective products and components; and

searching said information templates in order to identify suppliers of said product and said several interconnected components.

14. The method of Claim 13 further comprising the step of:

identifying at least one supplier of said product by use of said information templates.

15. The method of Claim 14 further comprising the step of:

identifying at least one supplier from a plurality of suppliers for each of said several interconnected components by use of said information templates.

16. The method of Claim 13, wherein the step of creating the information template further comprises the step of:

specifying a plurality of attributes related to the interrelationship of the product to other products.

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Evidence Appendix

NONE

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Related Proceedings Appendix

NONE